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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/404,570	09/23/99	MALHOTRA	D/99531

EXAMINER	
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ART UNIT	PAPER NUMBER
1714	10

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DATE MAILED: 05/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev.11/00)

1- File Copy

Advisory Action

Application No.	Applicant(s)
09/404,570	Malhotra et al.
Examiner	**Art Unit**
Callie Shosho	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED *Apr 17, 2001* FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
   (b) ☐ they raise the issue of new matter. (See NOTE below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

   NOTE: _____
4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
   Claim(s) allowed: *22*
   Claim(s) objected to: *None*
   Claim(s) rejected: *1-21, 23, and 24*
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ .
11. ☐ Other:

Attachment to Advisory Action

1. Applicants' arguments as set forth in the response filed 4/17/01 have been fully considered but they are not persuasive for the following reasons:

(a) With respect to the combination of Malhotra et al. with either Siddiqui or Watt and the combination of Malhotra et al. with Schwarz et al., applicants argue that the burden of establishing a case of obviousness rests with the examiner and the examiner may not make an assertion, unsupported by facts, of unpatentability and require the applicant to provide evidence to rebut the assertion especially given that the examiner has failed to establish a prima facie case of obviousness.

However, it is the examiner's position that a prima face case of obviousness has been made given that the examiner has provided motivations to combine the references, all the references are from the same general field of endeavor, i.e. inks, or in the case of Malhotra et al. in view of Schwarz et al., in the same field of endeavor, i.e. hot melt inks, and that the references when combined meet the claimed invention. Thus, examiner has properly met the burden of establishing a prima facie case of obviousness and thus "the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative data showing that the claimed invention possesses improved properties not expected by the prior art". See MPEP 2142.

(b) With respect to claims 4 and 7 which contain functional language, applicants argue that the courts have held that functional language cannot be ignored, In re Caldwell 39 F.2d 254, 38 USPQ 243 (CCPA 1963) and that there is nothing wrong with attempting to define something by what it does rather than by what it is, In re Swinehart, 439 F.2d 20, 69 USPQ 226 (CCPA 197).

As set forth in MPEP 2173.05(g), in In re Swinehart, the courts held that functional language does not, in and of itself, render a claim improper under 35 USC 112, second paragraph. However, examiner has never stated that the functional language is improper. Further, the examiner never ignored the functional language in the claims.

Rather, with respect to the time necessary for the ink to undergo a change from the solid to the liquid state (claim 4), examiner argued, and maintains, that not only does the ink composition of Malhotra et al. possess the same melting temperature as presently claimed, but further, Malhotra et al. taken in view of either Schwarz et al. or Siddiqui and Watt comprises the same ingredients as presently claimed, i.e. aldehyde copolymer, nonpolymeric aldehyde viscosity modifier, ink vehicle, colorant. In light of this, and absent evidence to the contrary, it is the examiner's position that the ink composition disclosed by Malhotra et al. taken in view of either Schwarz et al. or Siddiqui and Watt would require the same time to change from a solid state to a liquid state as presently claimed. Similarly, for the haze value (claim 7), on the one hand, the examiner argued that Malhotra et al. in view of either Schwarz et al. or Siddiqui and Watt disclose an ink with similar ingredients to those presently claimed, i.e. aldehyde copolymer,

nonpolymeric aldehyde, colorant, antioxidant, and UV absorber, and thus, absent any evidence to the contrary, it is natural to infer that the ink intrinsically possesses haze value as presently claimed, and on the other hand, when used in combination with Nishizaki et al., that to the extent that Nishizaki et al. disclose a hot melt ink comprising synthetic polymer and colorant suitable for use in ink jet printing and further disclose that such hot melt inks having a haze value of 0-30 exhibit superior light transmission properties, Nishizaki et al. remains a relevant reference against the present claims.

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4/27/01

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